

REMARKS

Reconsideration of the present application and entry of the remarks are respectfully requested. Claims 1 to 20 are currently pending, and no claims have been amended.

The Final Office Action mailed January 29, 2004 addressed claims 1 to 20. Claims 1 to 4, 6 to 9, 15, 16, 18 and 20 were rejected, claims 5, 17 and 19 were objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claim, and claims 10 to 14 were allowed.

Claims 1 to 4, 6 to 8, 15, 16 and 18 were rejected under 35 U.S.C. § 102(e) as being anticipated by Wong et al. (6,585,555). The Examiner stated that regarding claim 1, Wong discloses a ball comprising a core and a cover, and the cover includes a thermochromic material that changes according to temperature. The Examiner further stated that regarding claim 2, the thermochromic section is on the surface of the ball; regarding claim 3, the temperature indication is visible; regarding claim 4, the visible indication is in at least two parts, and several colors are permanently displayed while one or more colors change when the temperature changes; regarding claims 6 to 8, Wong discloses the thermochromic materials suitable for the invention are found in Nakasuji et al., which discloses the thermochromic material may include liquid crystals or leuco dye; and regarding claims 15, 16 and 18, Wong discloses a ball comprising a core and a cover, the cover includes a thermochromic material that changes according to temperature, and Wong discloses the thermochromic materials suitable for the invention are found in Nakasuji et al., which discloses the thermochromic material may include liquid crystals or leuco dye.

In the Response to Arguments, the Examiner stated that "Applicant further states that since a golf ball is not disclosed in the Wong the claims are not anticipated. The Examiner disagrees. One of ordinary skill in the art would define the term "golf ball" as a round object capable of being used in a game of golf or capable of being struck with a club, i.e., practice ball. The ball disclosed by Wong is definitely capable of being struck with a golf club during practice."

Applicant respectfully disagrees with the Examiner. As discussed in the previous response, Wong discloses a water toy ball with a porous absorbent core (preferably foam) that absorbs water and a preferably a fabric cover printed with graphics. Wong does not disclose or claim a golf ball of any type, with or without a section comprising a thermochromic material incorporated on the surface of the cover. Applicant's claims 1 and 15 require that the ball is a golf ball having a cover that incorporates a section comprising a thermochromic material. Using the logic of the Examiner,

a softball could also be called a "practice ball" because technically it is capable of being struck with a golf club, but Applicant respectfully submits that one skilled in the art would not refer to a softball or a soft toy ball as a practice ball for golf to be struck with a club. A "practice ball", when considered by one skilled in the art of golf, is a golf ball. It may be a golf ball with less features, such as a range ball, but it is still a golf ball. A soft water toy made with open cell foam would not have any of the same properties, physical or aerodynamic, as a golf ball. Applicant respectfully submits that the Examiner has mischaracterized the teachings of Wong, and Applicant respectfully requests that the Examiner reconsider the rejection.

Since, as discussed above, Wong does not teach each and every element of Applicant's claims 1 and 15 because Wong does not teach a golf ball, Applicant respectfully submits that Wong does not anticipate Applicant's claims. Claims 2 to 4, 6 to 8, 16 and 18 depend from claims 1 and 15 and are therefore also not anticipated by Wong. Applicant respectfully requests that the Examiner reconsider and withdraw the rejections of claims 1 to 4, 6 to 8, 15, 16 and 18 as anticipated by Wong under 35 U.S.C. § 102(e).

Claims 9 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wong et al. The Examiner stated that the additional cover layer is an obvious duplication of the first cover layer, and one of ordinary skill in the art would have included a second cover layer to increase the durability of the ball.

In the Response to Arguments, the Examiner stated that "Applicant also states that a *prima facie* case of obviousness has not been established. However, applicant does not provide reasons or comments supporting this position."

Applicant respectfully disagrees and is not sure why the Examiner stated that "applicant does not provide reasons or comments supporting" the position since Applicant did provide comments that supported the position. In the previous Response, Applicant disagreed with the Examiner and submitted that the Examiner had not made out a *prima facie* case of obviousness. The previous Response stated that Wong is deficient because it does not disclose Applicant's invention. Wong does not disclose a golf ball having a cover that incorporates a section comprising a thermochromic material, as required by Applicant's claims 1 and 15. Therefore, even if an additional cover layer is an obvious duplication of the first cover layer, which Applicant submits it is not, the addition of another cover layer does not cure the deficiency of Wong.

To further clarify, even if another cover layer was added, Wong would still not disclose

Applicant's invention since Wong is not a golf ball. Adding another layer to the toy ball of Wong would not disclose Applicant's invention. Furthermore, the Examiner has shown no suggestion or motivation in Wong to add another cover layer.

For at least these reasons, Applicant respectfully submits that claims 9 and 20 are not obvious over Wong et al. Applicant therefore respectfully requests that the Examiner reconsider and withdraw the rejection of claims 9 and 20 under 35 U.S.C. § 103(a) as obvious over Wong et al.

Claims 5, 17 and 19 were objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claim. Applicant respectfully submits that, as discussed above, claims 1 and 15 are not anticipated by Wong et al. and are allowable, therefore, claims 5, 17 and 19, which depend from claims 1 and 15, should also be allowable.

The Examiner is invited to telephone Applicant's attorney if it is deemed that a telephone conversation will hasten prosecution of the application.

CONCLUSION

Applicant respectfully requests reconsideration and allowance of each of the presently objected and rejected claims, claims 1 to 20. Applicant respectfully requests allowance of claims 1 to 20, the claims currently pending.

Respectfully submitted,

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